

Applicant Initiated Interview Request Form

Application No.: 10/822,617 First Named Applicant: Mark Weiss
Examiner: Thomas Lett Art Unit: 2625 Status of Application: Under ^{Final} _{rejection}

Tentative Participants:

(1) Clark Jablon (2) Mark Weiss
(3) Examiner Lett (4) Examiner Poon

Proposed Date of Interview: April 5, 2007 Proposed Time: 10:45 (AM/PM)

Type of Interview Requested:

(1) ☐ Telephonic (2) ☒ Personal (3) ☐ Video Conference

Exhibit To Be Shown or Demonstrated: ☐ YES

If yes, provide brief description: _____

☒ NO

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) <u>§101 rej</u>	<u>1, 3</u>	<u>none</u>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) <u>§102 rej</u>	<u>1, 3</u>	<u>Seymour</u>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/> Continuation Sheet Attached					

Brief Description of Arguments to be Presented:

See attached Agenda

An interview was conducted on the above-identified application on _____.

NOTE: This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

Clark Jablon
Applicant/Applicant's Representative Signature

Examiner/SPE Signature

Clark Jablon
Typed/Printed Name of Applicant or Representative

35039
Registration Number, if applicable

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Agenda for personal interview

1. Discussion of claim 1 prior art rejection

Comparison between claimed proofing paper having a combination of elements (a) and (b) of claim 1 vs. Seymour's paper that is either entirely blank and has no color bars printed thereon (i.e., element (a) exists, but element (b) does not exist), or has a content image portion and one or more portions of a color bar printed thereon (i.e., only element (b) exists).

2. Discussion of claim 3 prior art rejection

Examiner's new rationale that one patch can be a color bar, and one or more patches have a predefined relationship to the color bar made up of the patches.

Seymour states that his color bar is "comprised of individual color patches" wherein the patches "include solid patches and halftone patches for each of the primary ink colors, as well as a few solid overprints." By definition, Seymour's color patch therefore cannot be a color bar. Also, an artisan recognizes that a color bar will always have multiple colors, and thus one of Seymour's color patches cannot be a color bar.

3. Discussion of § 101 rejection

MPEP 706.03(a)

A. Printed Matter

For example, a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967).

a. **In re Jones**: Applicant's claimed color bars are "structure" analogous to the pattern areas in *Jones*.

That claim, and the others likewise, do not, in our opinion, define "printed matter" in the sense in which that term has heretofore been used to indicate various sorts of indicia whose primary purpose is the conveying of intelligence to a reader. What we find on the disk we would not characterize as indicia or printing but as structure, albeit the "pattern areas" of claim 1 are not necessarily transparent and opaque, respectively, and might be produced by some sort of printing technique. *In re Jones*, 153 USPQ 77 at 80-81 (underlining added for emphasis)

Certainly there is no "printing" in this case in the form of words or other symbols intended to convey intelligence to a reader nor in the form of rulings as on a business form. *Jones* at 81 (underlining added for emphasis)

b. **In re Miller**: Claim 1: Applicant's claimed color bars define a new and unobvious functional relationship between color bar indicia pre-printed on one region of proofing paper in relation to another region of the proofing paper.

Claim 3: Applicant's claimed color bars define a new and unobvious functional relationship between one or more standard first color bars pre-printed on proofing paper and the one or more second color bars that are printed in a predefined relationship to the one or more first color bars

Here there is a new and unobvious functional relationship between a measuring *receptacle*, volumetric *indicia* thereon indicating volume in a certain ratio to actual volume, and a *legend* indicating the ratio, and in our judgment the appealed claims properly define this relationship. *In re Miller*, 164 USPQ 46 at 49 (underlining added for emphasis)

c. **Ex parte Gwinn**: Case is not relevant because the analysis in *Gwinn* was based on a comparison of the claims to prior art references. Examiner stated on page 2 of the Final Rejection that principles of *In re Gulack* cited by Applicant are not relevant because "the decision in *Gulack* is based on a 103 prior art rejection, not a 101 non-statutory rejection."

Also, *Gwinn* is clearly distinguishable from the presently claimed invention because in *Gwinn*, the dots on the dice are "symbols intended to convey intelligence" (see quotation from *In re Jones* above), whereas Applicant's claimed color bars are "structure" analogous to the pattern areas in *Jones*.